

REMARKS

Applicants submit this Amendment in reply to the Office Action mailed July 13, 2005¹. In this Amendment, Applicants amend claims 37, 44, 45, 47, 54, 55, 58, 65, 66, 69, and 70 to more appropriately describe their invention.

Before entry of this Amendment, claims 1-140 were pending in this application, with claims 1-36 and 71-140 withdrawn from consideration. After entry of this Amendment, claims 1-140 remain pending in this application.

In the Office Action, the Examiner rejected claims 37-70 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,292,709 to Uhl et al. ("Uhl") and rejected claims 37-70 under 35 U.S.C. § 103(a) as being unpatentable over Uhl in view of Applicants' Admitted Prior Art and U.S. Patent No. 4,992,649 to Mampe et al. ("Mampe").

Claim Rejections Under 35 U.S.C. § 102(e)

Applicants respectfully traverse the rejection of claims 37-70 under 35 U.S.C. § 102(e) as being anticipated by Uhl. In order to properly establish that Uhl anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131,

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Uhl does not disclose each and every element of Applicants' claimed invention. Amended claims 37, 58, 69, and 70 recite, for example, "[an output subsystem], at a second site, for applying the reconstructed first code to the mailpiece." (Emphasis added). Support for the amendments to claims 37, 58, 69, and 70 can be found in the Applicants' specification at, for example, at page 13, lines 14-16; page 15, line 16 through page 16, line 4; page 17 line 7, through page 18, line 4; and Figures 6A and 6B. Concerning claim 47, the claim as amended recites "determining, at a second site after applying the identification code, that a first code previously placed on the mailpiece has become illegible." (Emphasis added). Support for the amendments to claim 47 can be found in the Applicants' specification, for example, at page 13, lines 14-16; page 15, line 16 through page 16, line 4; page 17 lines 7 through page 18, line 4; and Figures 6A and 6B.

The Examiner alleges that Uhl's "reconstruct[ion] of the first code (i.e., address) can be regarded as retrieval of the address block information from the ID-tag server via the ID-tag as taught by Uhl (col. 9, ln. 53- col. 10, ln. 13)." Office Action, page 3, ¶ 1. No part of Uhl, however, discloses applying a reconstructed address block, or barcode, to the mailpiece. Thus, Uhl fails to teach "[an output subsystem], at a second site, for applying the reconstructed first code to the mailpiece," as recited in amended claims 37, 58, 69, and 70.

Moreover, the Examiner alleges that Uhl uses an "identification code ('ID TAG') to obtain data corresponding to the mailpiece, wherein the data has been stored in the

server prior to the first code becoming illegible (col. 9, 34 et seq. teaching that ID tag is stored at 403).” Office Action, page 2, ¶ 5, through page 3, ¶ 1. On the contrary, Uhl discloses that “[i]tems which cannot be evaluated online during the intermediate storage will be imprinted with an ID-tag.” Uhl, col. 9 lines 53 and 54. In more detail, Uhl discloses a system where a failed comparison of the address block with the dictionary results in forwarding the address block to an online video coding system.” Uhl, col. 3, lines 8-21. Therefore, an ID-tag is only applied to an item where the online system fails to evaluate the item. Uhl, col. 9, lines 53 and 54. Accordingly, Uhl fails to teach “determining, at a second site after applying the identification code, that a first code previously placed on the mailpiece has become illegible,” as recited in amended claim 47. (Emphasis added).

Therefore, the Examiner’s rejection of claims 37, 47, 58, 69, and 70 under 35 U.S.C. § 102(e) is improper and must be withdrawn. Further, claims 38-46, 48-57, and 59-68 are also allowable at least at least by virtue of their dependence from claims 37, 47, and 58, respectively. Therefore, Applicants respectfully submit that claims 38-46, 48-57, and 59-68 are allowable over the Examiner’s anticipation rejection and must be withdrawn.

Claim Rejections Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 37-70 under 35 U.S.C. § 103(a) as being unpatentable over Uhl in view of Applicants’ Admitted Prior Art and Mampe. In order to properly establish *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the

claims. MPEP § 2143.03 (8th ed. 2001, 3d rev. August 2005). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Id. at § 2143.01. Third, a reasonable expectation of success must exist that the proposed modification will work for the intended purpose. Id. at § 2143.02. Moreover, each of these requirements must be found in the prior art, and not be based on Applicant's disclosure. Id. at § 2143.

At least the first requirement for establishing a *prima facie* case of obviousness has not been established because none of Uhl, Applicants' own admissions, or Mampe, either alone or in combination, teach or suggest all the elements of Applicants' claimed invention. None of Uhl, Applicants' own admissions, or Mampe teach or suggest, for example, "[an output subsystem], at a second site, for applying the reconstructed first code to the mailpiece," as recited in amended claims 37, 58, 69, and 70, or "determining, at a second site after applying the identification code, that a first code previously placed on the mailpiece has become illegible," as recited in amended claim 47.

As set forth above, Uhl fails to disclose or suggest "[an output subsystem], at a second site, for applying the reconstructed first code to the mailpiece," regarding amended claims 37, 58, 69, and 70, or "determining, at a second site after applying the identification code, that a first code previously placed on the mailpiece has become illegible," concerning amended claim 47. With respect to Mampe, the reference is silent with respect to a reconstructed first code or an identification code, and thus, cannot teach the above-noted claim elements.

Moreover, the Examiner apparently alleges that Applicants have admitted that use of an item code in addition to a bar code in instances when the bar code is illegible is prior art, citing to pages 4-6 of Applicants' specification. Even if the Examiner's allegation were correct, neither this portion nor any other portion of Applicants' specification teaches or suggests a "[an output subsystem], at a second site, for applying the reconstructed first code to the mailpiece," regarding amended claims 37, 58, 69, and 70, or "determining, at a second site after applying the identification code, that a first code previously placed on the mailpiece has become illegible," concerning amended claim 47. (Emphasis added). See, for example, Applicants' specification at page 12, lines 14 and 15; page 17, lines 4-15; page 21, lines 10-14; page 23, lines 15-17; and Figures 6A and 6B. Instead, page 5 of the Applicants' specification recites that "once the mailpiece has been processed and sorted based on the POSTNET code, the RBCS can no longer access the ITEM code, because the RBCS cannot store the ITEM code locally or transmit the ITEM code to other RBCS sites." (Emphasis added). Thus, neither pages 4-6 of Applicants' specification nor any other portion of Applicants' specification teaches or suggests a "[an output subsystem], at a second site, for applying the reconstructed first code to the mailpiece," regarding amended claims 37, 58, 69, and 70, or "determining, at a second site after applying the identification code, that a first code previously placed on the mailpiece has become illegible," concerning amended claim 47.

Accordingly, none of Uhl, Applicants' own admissions, or Mampe teach or suggest either this portion nor any other portion of Applicants' specification teaches or suggests a "[an output subsystem], at a second site, for applying the reconstructed first

code to the mailpiece," as recited in amended claims 37, 58, 69, and 70, or "determining, at a second site after applying the identification code, that a first code previously placed on the mailpiece has become illegible," as recited in amended claim 47. Thus, no *prima facie* case of obviousness has been established. Accordingly, the Examiner's obviousness rejection with respect to claims 37, 47, 58, 69, and 70 is improper and must be withdrawn.

Furthermore, claims 38-46, 48-57, and 59-68 are allowable at least by virtue of their dependence from claims 37, 47, and 58, respectively. Therefore, Applicants respectfully submit that claims 38-46, 48-57, and 59-68 are allowable over the Examiner's obviousness rejection and must be withdrawn.

Conclusion

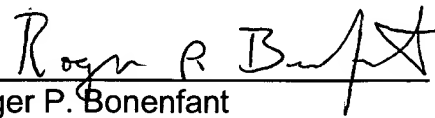
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 13, 2006

By: 
Roger P. Bonenfant
Reg. No. 58,030